

REMARKS/ARGUMENTS

In the restriction requirement dated October 7, 2009, the Examiner delineated the following inventions as being patentably distinct.

Group I: Claims 1-8, drawn to a multilayer structure; and

Group II: Claims 9-14, drawn to a process of forming a multilayer structure.

Applicants provisionally elect with traverse Group II.

Please note:

All of the original (Preliminary Amendment filed August 23, 2006) have been canceled and a new set of claims has been presented. The new claims find support in the originally filed claims. Accordingly, all of the present claims read on process claims, i.e., the elected invention. However, in order to be fully responsive, Applicants will argue the restriction requirement as originally presented by the Patent Examiner.

Restriction is only proper if the claims of the restricted Groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are independent or patentably distinct.

The claims of Groups I and II are related as product and process for making, and as such are considered as interdependent and should be examined together on the merits especially wherein the sole disclosed utility is that recited in the specification.

The claims of Group I define the invention of Group II. There is a commonality that exists between the Groups. It is a technical relationship that involves the same features, and it is this technical feature that defines the contribution which each of the Groups taken as a whole makes over the prior art.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. Product and method of making said product are considered related inventions under 37 C.F.R. § 1.475(b) and unity of invention between the groups exist.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.”

Applicants submit that a search of all the claims would not contribute a serious burden on the Office. In fact the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Report did not, the restriction is believed to be improper. 37 C.F.R. § 1.475(b) provides in relevant part that a “national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to --(3) a product and a method of making said product.”

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants request that if Group II is found allowable, Group I which includes the limitation of the allowable claims be rejoined.

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